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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,725	11/13/2002	Stephanie Caron	PC10604C	6160
23913	7590	02/18/2004	EXAMINER	
PFIZER INC 150 EAST 42ND STREET 5TH FLOOR - STOP 49 NEW YORK, NY 10017-5612			CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/065,725	Applicant(s) CARON ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 7-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application is divisional of SN 09/690,346. Claims 1-45 are in the case.

A restriction was made in the parent application and hereby listed as following:

- I. Claims 1, 7, 8, drawn to process of preparing formula Ia;
- II. Claims 2 and 3, drawn to process of preparing formula Via;
- III. Claims 4-6, drawn to mixture of formula Ia and Ib;
- IV. Claims 9-10, drawn to compounds of formula Ia and Ib;
- V. Claims 11-12 drawn to compounds of formula Va and Vb;
- VI. Claims 13-15 drawn process of preparing formula III;
- VII. Claims 16-27 drawn to process of preparing formula X;
- VIII. Claims 28-41 drawn to process of preparing formula XV;
- IX. Claims 41-44 drawn to process of preparing formula XVII;
- X. Claims 45-50 drawn to multiple compounds in different classes.

Group I invention was issued. The same restriction was also applicable in the instant case.

During a telephone conversation with Mr. Suskind on Jan. 21, 2004 a provisional election was made without traverse to prosecute the invention of group III, claims 4-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-3, 7-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Initially it is pointed out that the specification and claims of record in the electronic file are illegible. It is unclear of what is the structure of the compounds. From the pregrant publication US 2003/0236568, the claim 4 of the file has an "C" on the piperidinyl nitrogen which is improper. Clarification is required.

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Further, it is unclear as to "what" mixture is being claimed since the up and down bonding arrangement is not diastereomeric noted which one is the 90 which one is the 10 is unclear. Applicants are urged to consult US 6,239,147 wherein the stereo isomer is delineated by (1S:1R) or (1S,1S) etc. (see col. 17-18) for the isochroman ring. Explicit notation of stereo-position and its stereo-isomeric form is recommended.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/25714 or US 6,239,147.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Determination of the scope and content of the prior art (MPEP §2141.01)

Satake WO 99/25714 or Obach et al. US 6,239,147 disclosed mixtures of the instant claims with various ratio. (see '714 example 3 and 7, '147 examples 1-2).

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between Satake '714 mixture or Obach et al. '147 mixture and the instant claims is that the particular ratio of 90:10 or 98:2 was not specifically named. However, Satake '714 disclosed a 80-20, 75-25 ratio mixture in example 3 with further purification to a single diastereomer of example 7 and Obach et al. '147 disclosed a 80-20, 75-25 ratio mixture in example 1 with further purification to a single diastereomer of example 2.

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Finding of prima facie obviousness—rational and motivation (MPEP§2142-2143)

One having ordinary skill in the art would be in possession of the instantly claimed mixture with the more particular ratio. **because** various ratios have been made with different degree of purification from 25-75 to a single diastereomer. Applicants admit on page 5 of the specification that the mixture was made in the prior art with a less efficient process. Therefore, in view of the range and the explicit guidance disclosed in the prior art, the instant limited ratio is completely encompassed by the prior art, thus, in possession by one skilled in the art. In absence of unexpected results there is nothing unobvious in choosing some among many. In re Lemin 141 USPQ 814.

4. An abstract encompassing the elected invention is recommended.

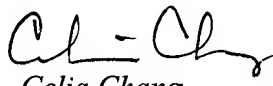
5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang


Celia Chang
Primary Examiner
Art Unit 1625